

for patent filed under this section, except for a provisional application under paragraph (c) of this section or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 U.S.C. 120, 121 or 365(c) and § 1.78(a).

(1) A continuation or divisional application that names as inventors the same or fewer than all of the inventors named in the prior application may be filed under this paragraph or paragraph (d) of this section.

(2) A continuation-in-part application (which may disclose and claim subject matter not disclosed in the prior application or a continuation or divisional application naming an inventor not named in the prior application) must be filed under this paragraph.

(c) *Application filing requirements - Provisional application.* The filing date of a provisional application is the date on which a specification as prescribed by the first paragraph of 35 U.S.C. 112, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No amendment, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to the provisional application after the filing date of the provisional application.

(1) A provisional application must also include the cover sheet required by § 1.51(c)(1) or a cover letter identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under paragraph (b) of this section.

(2) An application for patent filed under paragraph (b) of this section may be converted to a provisional application and be accorded the original filing date of the application filed under paragraph (b) of this section.

(i) Provided that a petition requesting the conversion, with the fee set forth in § 1.17(q), is filed prior to the earliest of:

(A) Abandonment of the application filed under paragraph (b) of this section;

## 201.07 Continuation Application

A continuation is a second application for the same invention claimed in a prior nonprovisional application and filed before the original becomes abandoned or patented. The continuation application may be filed under 37 CFR 1.53(b) or 1.53(d). The applicant in the continuation application must include at least one inventor named in the prior nonprovisional application. The disclosure presented in the continuation must be the same as that of the original application; i.e., the continuation should not include anything which would constitute new matter if inserted in the original application.

An application claiming the benefits of a provisional application under 35 U.S.C. 119(e) should not be called a "continuation" of the provisional application since the application will have its patent term calculated from its filing date, whereas an application filed under 35 U.S.C. 120, 121, or 365(c) will have its patent term calculated from the date on which the earliest application was filed, provided a specific reference is made to the earlier filed application(s), 35 U.S.C. 154(a)(2) and (a)(3).

At any time before the patenting or abandonment of or termination of proceedings on his or her earlier nonprovisional application, an applicant may have recourse to filing a continuation in order to introduce into the application a new set of claims and to establish a right to further examination by the primary examiner. An application under 37 CFR 1.53(d), however, must be filed prior to payment of the issue fee.

For notation to be put on the file wrapper by the examiner in the case of a continuation application, see MPEP § 202.02, unless a petition under 37 CFR 1.313(b)(5) is granted in the prior application.

Use Form Paragraph 2.05 to remind applicant of possible continuation status.

invention prior to the effective U.S. filing date of the copending application. See MPEP § 715; or

- (E) Filing a continuation application on or after November 29, 1999, and showing that the prior art and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. <

Where the applications are claiming the same patentable invention, a terminal disclaimer and an affidavit or declaration under 37 CFR 1.130 may be used to overcome a rejection under 35 U.S.C. 103 in a common ownership situation if the earlier filed application has matured into a patent. See MPEP § 718.

If a provisional rejection is made and the copending applications are combined into a single application and the resulting single application is subject to a restriction requirement, the divisional application would not be subject to a provisional or actual rejection under 35 U.S.C. 102(e) /103 since the provisions of 35 U.S.C. 121 preclude the use of a patent issuing therefrom as a reference against the other application. Additionally, the resulting continuation-in-part is entitled to 35 U.S.C. 120 benefit of each of the prior applications. This is illustrated in Example 2, below.

The following examples are instructive as to the application of 35 U.S.C. 102(e) /103 in applications filed prior to November 29, 1999<:

**Example 1.** Assumption: Employees A and B work for C, each with knowledge of the other's work, and with obligation to assign inventions to C while employed.

SITUATIONS	RESULTS
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*application.*

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(c) If a nonprovisional application, other than a reissue application, discloses unclaimed subject matter by an inventor or inventors not named in the application, the application may be amended to add claims to the subject matter and name the correct inventors for the application. When the application is involved in an interference, the amendment must comply with the requirements of this section and must be accompanied by a motion under § 1.634. Such amendment must be accompanied by:

- (1) A petition including a statement from each person being added as an inventor that the amendment is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intention on his or her part;
- (2) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or 1.47;
- (3) The fee set forth in § 1.17(i); and
- (4) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b)).

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37 CFR 1.48(c) provides for the situation where a nonprovisional application discloses unclaimed subject matter by an inventor or inventors not named in the application when an executed declaration under 37 CFR 1.63 was first filed. In such a situation, the nonprovisional application may be amended pursuant to 37 CFR 1.48(c) to add claims directed to the originally unclaimed but disclosed subject matter and also to name the correct inventors for the application based on the newly added claims. Any claims added to the application must be supported by the disclosure as filed and cannot add new matter.

- (a) *Application number* . Any papers received in the Patent and Trademark Office which purport to be an application for a patent will be assigned an application number for identification purposes.
- (b) *Application filing requirements - Nonprovisional application* . The filing date of an application for patent filed under this section, except for a provisional application under paragraph (c) of this section or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 U.S.C. 120, 121 or 365(c) and § 1.78(a).
- (1) A continuation or divisional application that names as inventors the same or fewer than all of the inventors named in the prior application may be filed under this paragraph or paragraph (d) of this section.
- (2) A continuation-in-part application (which may disclose and claim subject matter not disclosed in the prior application) or a continuation or divisional application naming an inventor not named in the prior application must be filed under this paragraph.
- (c) *Application filing requirements - Provisional application* . The filing date of a provisional application is the date on which a specification as prescribed by the first paragraph of 35 U.S.C. 112, and any drawing required by § 1.81(a) are

to be an application for a patent will be assigned an application number for identification purposes.

(b) *Application filing requirements - Nonprovisional application*. The filing date of an application for patent filed under this section, except for a provisional application under paragraph (c) of this section or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 U.S.C. 120, 121 or 365(c) and § 1.78(a).

(1) A continuation or divisional application that names as inventors the same or fewer than all of the inventors named in the prior application may be filed under this paragraph or paragraph (d) of this section.

(2) A continuation-in-part application (which may disclose and claim subject matter not disclosed in the prior application) or a continuation or divisional application naming an inventor not named in the prior application must be filed under this paragraph.

(c) *Application filing requirements - Provisional application*. The filing date of a provisional application is the date on which a specification as prescribed by the first paragraph of 35 U.S.C. 112, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No amendment, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to the provisional application after the filing date of the provisional application.

(1) A provisional application must also include the cover sheet required by § 1.51(c)(1) or a cover letter identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under paragraph (b) of this section.

(2) An application for patent filed under paragraph (b) of this section may be converted to a provisional application and be accorded the original filing date of the application filed under paragraph (b) of this section.

(i) Provided that a petition requesting the conversion, with the fee set forth in § 1.17(q),